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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,336	03/27/2002	Didier Marcel Corrand	CM2204M	1443

27752

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EXAMINER

PRATS, FRANCISCO CHANDLER

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,336

Applicant(s)

CORRAND ET AL.

Examiner

Francisco C. Prats

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 60-62 is/are pending in the application.
- 4a) Of the above claim(s) 60-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 60-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1651.

Election/Restrictions

Applicant's election with traverse of the group I invention, claims 50-59, and the species wherein polyvinyl alcohol is the polymeric material and amylase is the active ingredient, in the reply filed on September 23, 2004, is acknowledged. The traversal is on the ground(s) that groups I and II are closely interrelated from a patentability assessment point of view and because the search required for the two groups is sufficiently related so as to not create an undue burden. This is not found persuasive because, as pointed out in the restriction requirement, the delivery system of group I has uses which are not those claimed, i.e. delivery to a non-aqueous system, such as delivery to an organic system of enzyme-catalyzed synthesis. Thus, the patentability of the delivery system is not so tied to the claimed method of use as to make a patentability assessment of one necessarily a patentability assessment of the other. Moreover, notably, applicant has

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failed to concede that one group is necessarily obvious over the other.

As to the argued lack of burden, the present claims encompass products ranging from industrial enzyme applications (class 435, numerous subclasses), to therapeutic enzymes (class 424, numerous subclasses), to detergent applications (class 510, numerous subclasses) as well as generalized therapeutic carrier applications (classes 424 and 514, numerous subclasses in each). Thus, any argument regarding lack of burden clearly ignores the very broad subject matter encompassed by the current claims and the significant burden on search and examination presented thereby.

The requirement is still deemed proper and is therefore made FINAL.

Claims 60-62 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. As noted immediately above, applicant timely traversed the restriction (election) requirement in the reply filed on September 23, 2004.

Claims 50-59 are examined on the merits to the extent they read on the elected subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 50-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the metes and bounds of the recitation in claim 50 "adapted for stability upon contact with air and instability upon contact with water" are not clear. It is not clear what actual physical or structural properties are encompassed or excluded by this recitation. It is not clear that the term "adapted" actually requires any sort of stability or instability. Rather, the term suggests an intended result, which may or may not occur. Also, it is not clear what properties of the polymeric material are encompassed by the recitations "stability" and "instability." More specifically, it is not clear what criteria are required for determining

whether a particular polymeric material is stable, and what degree and type of degradation is encompassed by "stability" and what degree and type of degradation is not encompassed by the term stability. Because the claim language fails to provide a clear delineation between claim-encompassed subject matter and non-claim-encompassed subject matter, a holding of indefiniteness is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 50, 51 and 54-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Guerry et al (U.S. Pat. 4,176,079).

Guerry discloses a granular detergent composition which comprises a nondusting article, said nondusting article in turn comprising amylolytic enzymes (i.e., amylases, the elected species of active ingredient; see claim 1 at column 28, lines 49-51), said enzymes enclosed within a resin film which may be made of polyvinyl alcohol (i.e., the elected species of

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polymeric material; see claim 1 at column 28, lines 52-54; see also claim 9 at column 29, lines 15 and 16), said nondusting article being in the form of a foam (see claim 5, at column 29, lines 5 and 6), as recited in applicant's claims. As recited in applicant's claim 51, the nondusting article is readily dispersible in water (see claims 2 to 4 at column 28, line 61 through column 29, line 4). Moreover, the nondusting article contains the same plasticizers as recited in applicant's claims 56 and 57. See, e.g., claims 19 and 20, at column 30, lines 8-15; note in particular the combination of those plasticizers with polyvinyl alcohol as disclosed in claim 21 at column 30, lines 16 and 17. Lastly, note that the nondusting article of Guerry exists in three dimensions, thereby meeting the limitations required in claim 59, and absorbs water as recited in claim 59, as demonstrated by the fact that it contains the same ingredients as recited in the claims. A holding of anticipation over the cited claims is therefore required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 50-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guerry et al (U.S. Pat. 4,176,079).

As discussed above, Guerry is considered to anticipate claims 50, 51 and 54-59. Moreover, even if one of ordinary skill were not to immediately envisage the claimed embodiments, Guerry clearly suggests the desirability of a foamed composition comprising polyvinyl alcohol and amylases, wherein the compositions is dispersed, degraded or disintegrated upon

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contact with water, as recited in applicant's claims. Moreover, the determination of a suitable elastic modulus for the foam, as recited in claim 52, would have been a matter of routine optimization on the part of the artisan of ordinary skill preparing the foams of Guerry et al, Guerry disclosing that suitable tensile strength, which is a function of elasticity, is required to permit proper handling of the materials disclosed therein. See, e.g., column 3, lines 28-58. Thus, although Guerry does not explicitly disclose suitable elasticity values for his compositions, the determination of such values must be considered obvious under § 103(a).

Similarly, the selection of a particular density foam for Guerry's nondusting article, as recited in applicant's claim 53, would have been a matter of routine optimization on the part of the artisan of ordinary skill, the artisan of ordinary skill clearly recognizing that the degree of foaming would have directly affected the density of the resulting article, and ultimately thereby the properties of the detergent. Thus, while Guerry does not explicitly disclose the densities of his products, absent a demonstration of an unexpected result coming from a specific density article, a holding of obviousness is clearly required under § 103(a).

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Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 50-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 46-52, 54-61 and 64 of copending Application No. 10/089,356, and over claims 16-26, 29 and 32-38 of copending Application No. 10/089,353, and over claims 23-27 and 34-42 of copending application 10/089,330. Although the conflicting claims are not identical, they are not patentably distinct from each other because each of the copending applications' claims recites essentially the same composition -- a water dispersible foam composition formed of a polymeric material which may be polyvinyl alcohol, and which contains an active ingredient which may be an enzyme, in

particular an amylase enzyme. A terminal disclaimer is clearly required.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

As discussed immediately above, claims 50-59 are directed to an invention not patentably distinct from claims 23-27 and 34-42 of commonly assigned application 10/089,330, and claims 16-26, 29 and 32-38 of commonly assigned Application No. 10/089,353.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned 10/089,330, and 10/089,353, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was

made, or name the prior inventor of the conflicting subject matter.


A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francisco C. Prats whose telephone number is 571-272-0921. The examiner can normally be reached on Monday through Friday, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Francisco C. Prats
Primary Examiner
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